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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/152,059 09/11/98 WENGEL

J WENGEL-8

EXAMINER

HM22/0409

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RILEY, J

ART UNIT

PAPER NUMBER

1656

16

DATE MAILED:

04/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/152,059

Applicant(s)

Wengel et al.

Examiner

Jezia Riley

Group Art Unit

1656



☒ Responsive to communication(s) filed on Feb 21, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 29 and 141-208 is/are pending in the application.

Of the above, claim(s) 187-208 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 29 and 141-186 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 29 and 141-208 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION***Response to Remarks***

1. Applicants' arguments and amendments, filed on 2/21/01, have been approved and entered. They have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

2. The numbering of claims is not accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 147, 141-207 have been renumbered 141-208 respectively.

Newly submitted claims 187-208 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they are directed to nucleic acids which are different from the oligomers originally claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 187-208 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The disclosure is objected to because of the following informalities: The continuation data in the specification are incomplete.

If applicant desires priority under 35 U.S.C. § 119(e) based upon a parent application, specific reference to the parent application must be made in the instant application. It is noted that this appears as the first sentence of the specification following the title. Status of the parent application (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "Patent No." should follow the filing date of the parent application. If a parent application has

become abandoned, the expression "abandoned" should follow the filing date of the parent application. Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 29, 141-186 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over 76-100, 109-118 of Application No. 09/528,110. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and copending application 09/528,110 claims LNA modified oligonucleotides, LNA nucleotide analogues, and methods of

using an LNA modified oligonucleotides, and kits for isolation purification, amplification, detection, identification, quantification, or capture of natural or synthetic nucleic acids using an LNA modified oligonucleotide. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This rejection is maintained.

6. Claims 29, 141-186 are directed to an invention that is not patentably distinct from claims 76-100, 109-118 of commonly assigned copending application 09/528,110. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Applicant argues that the application are different because of the inversion of the C3 stereocenter in the sugar moiety.

This rejection is maintained as that there is no disclosure or support for this argument.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 29, 142-186 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 29, 142-144, 146, 147, 150, 151, 153, 167, 173, 176, 177-186 are vague and indefinite because they all depend from canceled claims.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).


A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

11. No claim is allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is (703) 305-6855. The Examiner may normally be reached Monday through Friday, 0900 - 1700 EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Gary Jones, may be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix Receptionist whose telephone number is (703) 308-0196.

Any necessary fax can be sent to (703) 308-4242.


JEZIA RILEY
PRIMARY EXAMINER